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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,881	04/15/2004	Daniel C. Wonak	4001379.0792	5657

34759 7590 03/25/2005

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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,881	Applicant(s) WONAK ET AL.	
	Examiner Stephen M. D'Agosta	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Preliminary Amendment

The preliminary amendment has been received and is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 and 16-20 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,778,824. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite nearly identical material as to scope, design and operation. While the application's independent claims tend to be somewhat broader (eg. don't recite a "POTS phone" or "Bluetooth functionality"), the claims nonetheless read on US 6,778,824. Comparing the claims, we see that this is true:

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CLAIM 1 (Application).

In an apparatus for coupling at least one telephone device to a radio network, which apparatus comprises coupling means for coupling the at least one telephone device to a transceiver of a radio mobile handset connected to the radio network, said coupling means comprising interface means providing at least some central-office functions to the at least one telephone device, the improvement comprising:

said coupling means comprising wireless-connectivity transceiver means for communicating with a remote wireless-connectivity-enabled transceiver of a mobile handset connected to a radio network,

said wireless-connectivity transceiver means being operatively connected to said interface means, and comprising means for generating signals for coupling said interface means to said wireless-connectivity-enabled transceiver of a radio mobile handset connected to a radio network, so that the at least one telephone device may be coupled to the radio network via a remote mobile handset, whereby the mobile handset is allowed mobility of movement relative to said apparatus;

said coupling means comprising disconnecting means for disconnecting the pairing of said wireless-connectivity transceiver means with the remote wireless-connectivity-enabled transceiver of a mobile handset when the mobile handset has been removed and is distant from said docking means and is engaged in a call via the radio network.

CLAIM 1 (Patent – US 6,778,824).

In an apparatus for coupling at least POTS-type telephone device to a radio network, which apparatus comprises coupling means for coupling the at least one POTS-like telephone device to a transceiver of a radio mobile handset connected to the radio network, said coupling means comprising interface means providing at least some central-office functions to the at least one POTS-like telephone device, the improvement comprising:

Said coupling means comprising docking means for receiving a mobile handset therein;

said coupling means comprising wireless-connectivity transceiver means for communicating with a remote wireless-connectivity-enabled transceiver of a mobile handset connected to a radio network,

said wireless-connectivity transceiver means being operatively connected to said interface means, and comprising means for generating signals for coupling said interface means to said wireless-connectivity-enabled transceiver of a radio mobile handset connected to a radio network, so that the at least one telephone device may be coupled to the radio network via a remote mobile handset, whereby the mobile handset is allowed mobility of movement relative to said apparatus;

said coupling means comprising disconnecting means for disconnecting the pairing of said wireless-connectivity transceiver means with the remote wireless-connectivity-enabled transceiver of a mobile handset when the mobile handset has been removed and is distant from said docking means and is engaged in a call via the radio network and restoring means for restoring the pairing thereof after the mobile handset has terminated the call.

The primary examiner points out that; 1) the application teaches “telephone devices” which reads on “POTS-like phones” from US 6,778,824, 2) The application

teaches "docking means" (see last paragraph) and therefore provides inherency for "said coupling means comprising docking means for receiving a mobile handset therein" from the patent, and 3) Lastly, the patent teaches "restoring means for restoring the pairing thereof after the mobile handset has terminated the call" which is inherent in the application since the system both disconnects (see last paragraph) and restores a connection depending on how the user operates the system.

The application also teaches an apparatus and system which have similar claims that read on the patent as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
PRIMARY EXAMINER
3-22-2005

A handwritten signature in black ink, appearing to be 'SD' or 'D'Agosta', located below the typed name.